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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/945,293      | 08/31/2001  | Jonathan Houze       | 018781-005930US     | 2033             |

20350 7590 06/25/2003

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| EXAMINER |
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RAYMOND, RICHARD L

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| ART UNIT | PAPER NUMBER |
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1624

DATE MAILED: 06/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/945,293

Applicant(s)

HOUZE ET AL.

Examiner

Richard L. Raymond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 1-5,7,9-18,20-24,26-30 and 32-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6,8,19,25,31,36,38 and 40 is/are rejected.
- 7) ☒ Claim(s) 37,39 and 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment of April 1, 2003 added new claims 36-41. Accordingly, the claims now pending are claims 1-41.

### ***Election/Restrictions***

2. Claims 1-5, 9-18, 20-24, 26-30 and 32-35 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6. Applicants' traversal has been considered but is not seen convincing of error in the present requirement. It is maintained that structurally diverse products are involved.

Accordingly, the requirement is repeated and made final.

3. Pursuant to the requirement for election of species, applicants have elected the first compound of Figure 2A. Claims 6, 8, 19, 25, 31 and 36-41 are readable thereon. Claim 7 stands withdrawn as not readable on the elected species.

### ***Improper Markush Rejection***

4. Claims 6, 8, 9, 25, 31, 36, 38, and 40 are rejected as being improper Markush claims in the definitions of the A<sub>3</sub>, X and A<sub>2</sub> variables. The total resulting compounds are alkyl, cyclic and heterocyclic amides, sulfur amides and amines which lack a common core and are

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structurally diverse and patentable distinct one from the others. A reference anticipating one under 35 USC 102 would not be a reference against the others under 35 USC 103. Additionally, an undue search burden is involved. Note that searches in various subclasses in classes 540, 544, 546, 548, 549, 560, 562 and 564 and the corresponding subclasses of use class 514, as well as in STN/CAS are involved. Limitation of the claims to aryl amides, encompassing the elected species, will overcome this rejection.

***Claim Rejections - 35 USC § 112***

5. Claims 38 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Reference to figures in the drawings for the intended compounds renders the claims indefinite. The claims should be complete in themselves. Inclusion of the intended formulas directly in the claims is suggested.

***Claim Rejections - 35 USC § 102 / 35 USC § 103***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 6, 8 and 19, drawn to products, are rejected under 35 U.S.C. 103(a) as being unpatentable over Baldwin et al., Kawada et al., Chiyoumaru et al. or Schwartz. These patents disclose specific N-phenyl benzamides. See the generic formulas as well as the species therein. Note that the present product claims in addition to encompassing unsubstituted N-phenyl benzamide, encompass the species of the patent. Where not anticipated, the present compounds are generically taught. One would be motivated to prepare the present compounds from within the genus of the references and/or to prepare the simple homologs and analogs of the species of the references with the reasonable expectation of obtaining additional useful compounds. In the absence of a showing of unexpected properties, no patentable significance is seen in the present selection.

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*Allowable Subject Matter*

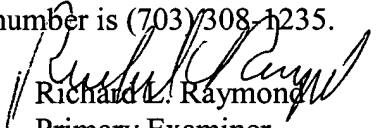
10. Claims 37, 39 and 41, drawn to the elected species, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, or upon allowance of claims generic thereto.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Raymond whose telephone number is (703) 308-4523. The examiner can normally be reached on Monday-Thursday (9:30AM-8:00PM)).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 305-4716. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
Richard L. Raymond  
Primary Examiner  
Art Unit 1624

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June 24, 2003